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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/070,601	Applicant(s) KURODA ET AL.	
	Examiner Gina C. Yu	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-25 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of Amendment filed March 29, 2004. Claims 1 and 3-25 are pending. Claim rejection made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action dated December 12, 2003, is withdrawn in view of claim amendment. Claim rejections made under 35 U.S.C. § 103(a) as indicated in the same Office action are maintained for the reasons of record. The same rejections are reproduced herein. New rejections are made to address amended and newly submitted claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is rejected as depending on a cancelled claim, claim 2.

Claim 14 is rejected as depending on an indefinite claim.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1, 3- 9, 12, 15,19-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Suzuki (US 5061481) in view of Sakuta (US 4970252).

Suzuki teaches a composition comprising methylphenylpolysiloxane (nonvolatile low viscosity silicone oils, of instant claims 3, 6, and 7) and dimethylpolysiloxane, both having viscosity of 10 cs; acryl-silicone graft copolymer and partially cross-linked organopolysiloxane polymer (instant claims 8 and 12). See Example 11. The example also contains a composition comprising titanium dioxide in Example 12. See instant claims 20 and 24. The reference also teaches that the invention is a composition comprising volatile silicone oils such as octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane. See col. 11, lines 3 – 8; instant claims 3-5. The reference teaches that any silicone oils having a viscosity below 50 cs can be used as the low viscosity silicone oil. See col. 5, lines 31 – 43. The reference further teaches that perfluoroalkyl(methyl)acrylates can be also used to form the acryl-silicone graft copolymer of instant claims. See, col. 3, line 58 – col. 4, line 17. See instant claim 19.

While the reference teaches that any liquid silicone oil can be used the reference and particularly mentions octa- and deca-methylcyclopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention the organopolysiloxane of formula (I) of instant claims 1 and 24 (methlytris(trimethylsiloxy)silane). See col. 5, lines 31 – 42. The reference teaches that 2 or more of low viscosity silicone oils can be used in combination if necessary. See col. 6, lines 44 – 48.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6. The reference teaches other types of low viscosity silicone oils, such as cyclic

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dimethylpolysiloxane, methylpolysiloxane, methylphenylpolysiloxanes, which suggests that the silicone oil of instant claim 1, formula (I) is comparable substitute for other low viscosity silicone oil also well known in the art. Methlytris(trimethylsiloxy)silane is said to have 1 mm² /s (cSt). See col. 4, lines 16 – 35. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition of Suzuki by adding methlytris(trimethylsiloxy)silane as motivated by Suzuki and Sakuta because of the expectation of successfully producing a similar cosmetic composition.

Alternatively, it is generally considered prima facie obvious to combine two compounds each of which is taught by the prior art to be useful for the same purpose, in order to form a composition which is to be used for the very same purpose. The idea for combining them flows logically from their having been used individually in the prior art. See In re Kerkhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980). As shown by the recited teachings, the instant claims define nothing more than the concomitant use of two conventional low viscosity silicone oils well known in cosmetic art. It would follow that the recited claims define prima facie obvious subject matter.

2. Claims 1, 8, 9, 12, 20, 21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Mellul (US 5496554) in view of Sakuta (US 4970252).

Mellul teaches cosmetic composition comprising a silicone gum, a silicone wax, and a silicone resin, and low-viscosity silicone oil. See col. 3, line 1 – col. 5, line 21; Example 4. The reference teaches using silicone polysiloxane gums having MW of 200K-1000K, and particularly mentions to use polymethylsiloxanes. See col. 3, lines 31

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– 49. See instant claims 8 and 9. Example 4 also contains mica and talc. The reference in col. 5, lines 55 – 58 also teaches iron oxides, which are well known UV screening agents. See instant claims 20, 21, and 24. The reference also teaches trimethylsiloxysilicate in the compositions. See Examples; instant claims 8 and 12.

Mellul fails to teach the silicone oil of instant claim 1, formula (I).

Sakuta ('252), as discussed above, teaches methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methlytris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

3. Claims 1, 8, 10, 11, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Gers-Barlag (US 6436413 B1) in view of Sakuta (US 4970252).

Gers-Barlag teaches a cosmetic emulsion comprising Aerosil R97s (polyalkylsilsesquioxane particles). See Examples; col. 10, lines 39 – 49. The reference also teaches low viscosity silicone oils such as octamethylcyclotetrasiloxane, hexamethylcyclotrisiloxane, polydimethylsiloxane, polymethylphenylsiloxane are useful in oily phase. Example 3 contains titanium dioxide, glycerine, and xanthan gum. See instant claims 20-24.

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The reference fails to teach the silicone compound in claim 1, formula (I).

Sakuta ('252) teaches methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Mellul by substituting the low viscosity silicone oil with methlytris (trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

4. Claims 1, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Sakuta (US 6503519 B1) ('519) in view of Sakuta (US 4970252) ('252).

'519 teaches a cosmetic composition comprising a crosslinked silicon polymer and a low viscosity silicone oil having viscosity of less than 100 cSt. See abstract. See instant claims 15 and 17. In claim 17, the "swollen" state of the crosslinked silicone polymer would necessary occur in the composition having the low viscosity silicone oil. The reference teaches that the organohydrogenpolysiloxanes are prepared from polyoxyalkylene having a Si-H bond and a polyoxyalkylene having 2 alkylenes per mole. See col. 5, lines 64 – col. 58. See instant claims 16 and 17. The reference fails to teach the compound of instant claim 1, formula (I).

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition '519 by substituting the low

viscosity silicone oil with methlytris (trimethylsiloxy) silane as motivated by '252 because of the expectation of successfully producing a similar cosmetic composition.

5. Claims 1, 3, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (US 6395857 B1) in view of Sakuta ('252).

Suzuki teaches a cosmetic composition comprising amino-modified silicone, used as a gelling agent for low-viscosity silicone oil. See abstract; col. 4, lines 1-28. See instant claims 13 and 14. Example 1 teaches that the amino-modified silicone has viscosity of 100 cSt at 25 °C. See instant claim 3. While the reference teaches that any liquid silicone oil can be used the reference and particularly mentions octa- and deca-methylcyclopentasiloxanes, dimethylpolysiloxane, and methylphenylpolysiloxane, the reference fails to particularly mention methlytris (trimethylsiloxy) silane. See col. 5, lines 1 – 11.

Sakuta ('252) teaches that methlytris(trimethylsiloxy)silane, the silicone oil of instant claims 1 and 24, formula (I), is well known in cosmetic art. See Example 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the composition in Suzuki by substituting the low viscosity silicone oil with methlytris(trimethylsiloxy)silane as motivated by Sakuta ('252) because of the expectation of successfully producing a similar cosmetic composition.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Suzuki and Sakuta as applied to claims 1, 3- 9, 12, 15,19-21, and 24 as above, and further in view of Starch (US 6121383).

Suzuki teaches that basic purpose of cosmetic composition is to impart moisturizing properties and that humectants are used for this reason. See col. 1, lines 22 – 29. The reference at col. 16, lines 56 – 68 also teaches to add humectant to the invention. The application of the invention includes solid foundation, liquid foundation, O/W emulsion, stick eyeshadow, and cream. See Examples.

Suzuki and Sakuta fail to teach the non-elastomer solid polysiloxanes of instant claim 25.

Starch teaches a method of thicken water-in-silicone emulsion which is useful in formulating cosmetics, including liquid foundations, antiperspirants, and skin moisturizers. See col. 1, lines 21 – 28. The reference teaches to add the latex in water phase rather than in silicone phase to delay swelling until the contact of the two phases to facilitate processing. See col. 1, lines 34 – 42. The reference teaches using cyclic siloxanes such as octamethylcyclotetrasiloxane, decamethylcyclopentasiloxane for the silicone phase. The reference teaches that trimethylsiloxysilicate, an MQ resin, is blended in film-forming organic polysiloxanes to make a silicone emollient. See col. 5, lines 10 – 38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the combined references by adding the silicone emollient comprising trimethylsiloxysilicate as motivated Starch, because 1) all references are directed to cosmetic compositions; 2) Suzuki teaches using emollients; 3) and the skilled artisan would have had expected to successfully produce a cosmetic composition with emolliency.

Response to Arguments

Applicant's arguments filed March 29, 2004 have been fully considered but they are not persuasive.

Applicants assert that it would not have been obvious to use methytris(trimethylsiloxy)silane (M3T) disclosed in Sakuta to make a cosmetic composition because M3T in Sakuta is used to make an intermediate product rather than a final cosmetic product.

It is understood that M3T is used in the polymerization process as both reactant and diluent rather than as an actual component by itself in the final product. However, examiner views the obviousness rejection is proper because 1) each of the primary references and Sakuta are specifically directed to cosmetic compositions; and 2) each of the primary references teach using low-viscosity silicone oils which, according to Sakuta, are equivalent to M3T to make a cosmetic component. Thus, examiner views that M3T and other low viscosity silicone oils that are disclosed in Sakuta and the primary references are art-recognized equivalents or substitutes.

Applicants also assert that M3T provides improved cosmetic properties over other low-viscosity silicone oils. The comparison data in specification pp. 36-38 were fully considered. While it is not clear what "D4" component is, nonetheless it is noted that the specification shows evaluation results by 10 panelists who reported that the compositions comprising M3T provides "durability for coverage " and "fresh feel" than compositions comprising D5 (decamethylcyclopentasiloxane) by 42 and 39, compared to 29 and 16, respectively. Examiner views that the evidence does not sufficiently to

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show nonobvious or unexpected results. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, M3T and decamethylcyclopentasiloxane are art-recognized substitute for each other.

Examiner views that the minor difference in the reported sensory opinions may be due to different properties of the M3T compound itself, which would naturally flow from using it in a cosmetic composition as motivated by the combined teachings of the references, rather than a greater than expected result. See MPEP § 716.02. Examiner also takes the position that opinion evidence alone cannot be given probabative value to determine the ultimate legal conclusion of whether the present invention is an obvious variation of the prior arts. See MPEP § 716.01(C).

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER